

REMARKS

Claims 17-24, 27-28 and 30-39 are pending in the present application. By this Amendment, previously presented claims 17, 35, 37 and 39 are amended. Applicants respectfully request reconsideration of the present claims in view of the foregoing amendments and the following remarks.

Entry of the above amendment is proper under 37 C.F.R. §1.116(a) in that the above amendment (1) places the claims in condition for allowance; (2) places the claims in better condition for consideration on appeal, if necessary; (3) does not raise any new issues; and (4) does not add new claims without canceling a corresponding number of claims. For the reasons given above, entry of the above amendment under 37 C.F.R. §1.116 is respectfully requested.

It should be noted that independent claims 17 and 35 have been amended as shown above by incorporating a portion of claims 37 and 39 into independent claims 17 and 35 respectively. For at least the reasons given below, previously presented claims 37-39 should have been indicated as being allowable over the art of record in the August 10, 2005 Office Action. Since this was not done, Applicants respectfully submit that the finality of the August 10, 2005 Office Action is premature and should be withdrawn.

I. Prior Art Rejections:

Rejection of Previously Presented Claims 17-18, 21, 23-24, 35-37 and 39 Under 35 U.S.C. §102(b) In View Of PCT Publication No. WO91/10562 (Ochi)

Previously presented claims 17-18, 21, 23-24, 35-37 and 39 are rejected under 35 U.S.C. §102(b) as being anticipated by International Patent Publication No. WO91/10562 to Ochi et al. (hereinafter, "Ochi"). This rejection is respectfully traversed.

In order for the disclosure of Ochi to anticipate Applicants' claimed invention as embodied in independent claims 17 and 35, the disclosure of Ochi must disclose each and every claim feature recited in independent claims 17 and 35. The disclosure of Ochi fails to teach or suggest at least the following claim features: an article comprising a polyurethane substrate that is derived from an aqueous urethane dispersion (claims 17 and 35). Accordingly, the disclosure of Ochi cannot anticipate Applicants' claimed invention as embodied in independent claims 17

and 35. Since claims 18, 21, 23-24, 36-37 and 39 depend from independent claims 17 and 35, and recite additional claim features, the disclosure of Ochi cannot anticipate Applicants' claimed invention as embodied in dependent claims 18, 21, 23-24, 36-37 and 39.

For at least the reasons given above, the disclosure of Ochi fails to anticipate Applicants' claimed invention as embodied in claims 17-18, 21, 23-24, 35-37 and 39. Accordingly, Applicants respectfully request withdrawal of this rejection.

In paragraph 6 on page 2 of the August 10, 2005 final office action, Examiner Bissett states:

Regarding the limitations to the substrate derived from an aqueous dispersion and the polyurethane clear coat layer, if any, derived from a solvent-based layer, it is noted that these limitations follow product-by-process format. Since the solvent or aqueous medium would not be present in the final article, which is claimed, it is the examiner's position that polyurethane layers formed by aqueous dispersions would be indistinguishable from those formed from solution.

Applicants disagree.

Applicants respectfully submit that the issue of concern in an anticipatory rejection is whether the disclosure of Ochi discloses a polyurethane substrate derived from an aqueous urethane dispersion. As noted by the Court, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicants respectfully submit that the disclosure of Ochi does not disclose an article comprising a polyurethane substrate derived from an aqueous urethane dispersion, and therefore, cannot anticipate claims 17-18, 21, 23-24 and 35-36.

Although the above-referenced issue raised by Examiner Bissett is not an issue in an anticipatory rejection, namely, whether polyurethane layers formed by aqueous dispersions would be indistinguishable from those formed from solution, Applicants note that this issue was addressed in parent application, U.S. Patent Application No. 09/571,573 (the '573 case). In the '573 case, Applicants submitted a December 21, 2001 Declaration Under 37 C.F.R. §1.132 by Dennis Falaas, one of the inventors of the present application, which clearly showed that polyurethane layers formed by aqueous dispersions are substantially different from polyurethane

layers formed from a solvent-based solution. In particular, polyurethane layers formed by aqueous dispersions have much higher elongation and tear strength properties compared to polyurethane layers formed from a solvent-based solution. A copy of the December 21, 2001 Declaration is attached.

Rejection of Previously Presented Claims 19-20 and 22 Under 35 U.S.C. §103(a) In View Of Ochi In Combination With Dunning

Previously presented claims 19-20 and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over the teaching of Ochi in combination with U.S. Patent No. 4,101,698 issued to Dunning et al. (hereinafter, "Dunning"). This rejection is respectfully traversed.

In paragraph 9 on page 3 of the August 10, 2005 final office action, Examiner Bissett states:

Nippon Carbide applies as above, teaching several metals for the metal layers but failing to mention the use of indium or tin materials or the use of primers. Dunning applies as above, where indium and tin materials are noted as equivalents to other metals, including nickel, silver, chromium, and aluminum (col., 2 lines 1-13). The metals are highly reflective and capable of being vacuum deposited. Thus, it is the examiner's position that it would have been prima facie obvious to use indium, tin, or alloys thereof in Nippon Carbide's invention with the expectancy of forming equally reflective and processible metal layer. Also, Dunning teaches that primer layers can be used on the metal layer to improved adhesion between the laminate and the substrate to be bonded (col. 6 lines 14-35). Thus, it is the examiner's position that it would have been prima facie obvious to use a primer layer in the laminates of Nippon Carbide to improve adhesion to bonding substrates.

Applicants disagree.

Applicants respectfully submit that there is no suggestion or motivation in the art of record for the need to modify the laminated resin films disclosed in the teaching of Ochi as suggested in Examiner Bissett's obviousness-type rejection. Examiner Bissett appears to suggest that it would have been possible to substitute indium or tin (disclosed in the teaching of Dunning) for one of the specific metals disclosed in the teaching of Ochi. Such reasoning has been frown upon by the Court. See, for example, *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990), wherein the Court states "The mere fact that references can be combined or

modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (In *Mills*, claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. The prior art reference taught that the feed means can be run at a variable speed, however the court found that this does not require that the output pump be run at the claimed speed so that air is drawn into the mixing chamber and is entrained in the ingredients during operation. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *Id.* at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

Alternatively or in addition, Examiner Bissett appears to suggest that it would have been obvious to try indium or tin (as disclosed in the teaching of Dunning) in the disclosed laminated resin films disclosed in the teaching of Ochi. Such an "obvious-to-try" rejection is improper. As noted by the CCPA in *In re Tomlinson*, 363 F. 2d 928, 931, 150 USPQ 623, 626 (CCPA 1966), "there is usually an element of 'obviousness to try' in any research endeavor, that it is not undertaken with complete blindness but rather with some semblance of a chance of success." Permitting patentability determinations based on an "obvious to try" test "would not only be contrary to statute but result in a marked deterioration of the entire patent system as an incentive to invest in those efforts and attempts which go by the name of 'research.'" *Id.*

For at least the reasons given above, Applicants respectfully submit that Examiner Bissett has failed to make a *prima facie* case of obviousness. Applicants respectfully submit that there is no suggestion or motivation in the art of record for the proposed combination of the teaching of Ochi and the teaching of Dunning, and therefore the proposed combination fails to make obvious Applicant's claimed invention as embodied in claims 19-20 and 22. Accordingly, Applicant respectfully requests withdrawal of this rejection.

Rejection of Previously Presented Claims 27-28, 30-31 and 38 Under 35 U.S.C. §103(a)
In View Of Dunning In Combination With Kunevicius

Previously presented claims 27-28, 30-31 and 38 are rejected under 35 U.S.C. §103(a) as being unpatentable over the teaching of Dunning in combination with U.S. Patent No.

3,439,950 issued to Kunevicius (hereinafter, "Kunevicius"). This rejection is respectfully traversed.

Applicants' claimed invention, embodied in independent claim 27, is drawn to an article comprising, *inter alia*, (i) a continuous, opaque layer of metal; (ii) a polyurethane substrate on a surface of the layer of metal; and (iii) at least one backing on a surface of the layer of metal opposite the polyurethane substrate, the backing comprising a pressure-sensitive adhesive foam tape.

The disclosure of Dunning discloses a laminate comprising: an adhesive layer, a reflective metal layer, an elastomeric film, a release coat and a carrier. See, for example, film 10 shown in FIG. 1, wherein film 10 comprises adhesive layer 20, reflective metal layer 18, elastomeric film 16, release coat 14 and carrier 12.

The teaching of Dunning fails to disclose, teach or suggest an article as recited in independent claim 27, namely, an article comprising a polyurethane substrate on a surface of a layer of metal, wherein the article further comprises a pressure-sensitive adhesive foam tape.

Examiner Bissett acknowledges that the teaching of Dunning fails to disclose, teach or suggest an article as recited in independent claim 27, but concludes that Applicants' claimed invention would have been obvious given the combined teaching of Dunning with the teaching of Kunevicius. Examiner Bissett specifically states in paragraph 11 on page 4:

Dunning applies as above, noting the application of PSA materials to the metal layer but failing to mention the use of an adhesive foam tape. Kunevicius teaches that foam tapes are used to apply molding materials to automobile body, where the foam serves to improve vibration absorption to prevent delamination (col. lines 18-51). It is the examiner's position that it would have been *prima facie* obvious to use foam tapes as the adhesive in Dunning's invention to improve vibration absorption and prevent delamination.

Applicants disagree.

The teaching of Kunevicius is directed to a resilient bumper molding or strip that can be adhesively attached to a vehicle. The disclosed molding comprises a body 10, a cellular cushion 14 positioned on a rear surface of body 10, and a pressure sensitive adhesive layer 15 on a rear surface of cellular cushion 14. The cushion layer 14 is not a pressure-sensitive adhesive

foam tape as recited in independent claim 27. Further, the pressure sensitive adhesive layer 15 is not a pressure-sensitive adhesive foam tape as recited in independent claim 27. In addition, the disclosed molding does not comprise a metal layer as recited in independent claim 27.

It is respectfully submitted that even if the proposed combination of the teaching of Dunning with the teaching of Kunevicius is proper (and Applicants are of the opinion that there is no motivation or suggestion in the art for such a proposed combination), the resulting combined teaching of Dunning and Kunevicius still fails to disclose, teach or suggest Applicants' claimed invention as embodied in independent claim 27 and dependent claims 28, 30-31 and 38. The resulting combined teaching of Dunning and Kunevicius still fails to disclose, teach or suggest an article comprising a polyurethane substrate on a surface of a layer of metal, wherein the article further comprises a pressure-sensitive adhesive foam tape.

For at least the reasons given above, the proposed combination of the teaching of Dunning and the teaching of Kunevicius fails to make obvious Applicants' claimed invention as embodied in claims 27-28, 30-31 and 38. Accordingly, Applicants respectfully request withdrawal of this rejection.

Rejection of Previously Presented Claims 27-28, 30-34 and 38 Under 35 U.S.C. §103(a)
In View Of Ochi In Combination With Kunevicius

Previously presented claims 27-28, 30-34 and 38 are also rejected under 35 U.S.C. §103(a) as being unpatentable over the teaching of Ochi in combination with Kunevicius. This rejection is respectfully traversed.

A description of Applicants' claimed invention as embodied in independent claim 27 may be relied upon above. A description of the teachings of Ochi and Kunevicius may also be relied upon above.

The teaching of Ochi fails to disclose, teach or suggest an article as recited in independent claim 27, namely, an article comprising a polyurethane substrate on a surface of a layer of metal, wherein the article further comprises a pressure-sensitive adhesive foam tape.

It is respectfully submitted that even if the proposed combination of the teaching of Ochi with the teaching of Kunevicius is proper (and Applicants are of the opinion that there is no motivation or suggestion in the art for such a proposed combination), the resulting combined

teaching of Ochi and Kunevicius still fails to disclose, teach or suggest Applicants' claimed invention as embodied in independent claim 27 and dependent claims 28, 30-34 and 38. The resulting combined teaching of Ochi and Kunevicius still fails to disclose, teach or suggest an article comprising a polyurethane substrate on a surface of a layer of metal, wherein the article further comprises a pressure-sensitive adhesive foam tape.

For at least the reasons given above, the proposed combination of the teaching of Ochi and the teaching of Kunevicius fails to make obvious Applicants' claimed invention as embodied in claims 28 and 30. Accordingly, Applicants respectfully request withdrawal of this rejection.

II. Double Patenting Rejections:

Obviousness-Type Double Patenting Rejection of Previously Presented Claims 17-23 and 37 In View Of Claims 1-11 of U.S. Patent No. 6,071,621

Previously presented claims 17-23 and 37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,071,621. This rejection is respectfully traversed.

Applicants respectfully submit that pending claims 17-23 and 37 are patentably distinct from claims 1-11 of U.S. Patent No. 6,071,621. However, Applicants submit herewith a terminal disclaimer disclaiming any portion of the patent term of the present application that would extend beyond the patent term of U.S. Patent No. 6,071,621 in order to expedite prosecution of the present application. Accordingly, Applicants respectfully request withdrawal of this rejection.

Obviousness-Type Double Patenting Rejection of Previously Presented Claims 24, 35-36 and 39 In View Of Claims 1-11 of U.S. Patent No. 6,071,621 and Ochi

Previously presented claims 24, 35-36 and 39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,071,621 in view of the teaching of Ochi. This rejection is respectfully traversed.

Applicant respectfully submits that pending claims 24, 35-36 and 39 are patentably distinct from claims 1-11 of U.S. Patent No. 6,071,621 in view of the teaching of Ochi. However, Applicants submit herewith a terminal disclaimer disclaiming any portion of the patent term of the present application that would extend beyond the patent term of U.S. Patent No. 6,071,621 in order to expedite prosecution of the present application. Accordingly, Applicants respectfully request withdrawal of this rejection.

Obviousness-Type Double Patenting Rejection of Previously Presented Claims 27-28, 30-34 and 38 In View Of Claims 1-11 of U.S. Patent No. 6,071,621 and Ochi and Kunevicius

Previously presented claims 27-28, 30-34 and 38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,071,621 in view of the teachings of Ochi and Kunevicius. This rejection is respectfully traversed.

Applicants respectfully submit that pending claims 27-28, 30-34 and 38 are patentably distinct from claims 1-11 of U.S. Patent No. 6,071,621 in view of the teachings of Ochi and Kunevicius. However, Applicants submit herewith a terminal disclaimer disclaiming any portion of the patent term of the present application that would extend beyond the patent term of U.S. Patent No. 6,071,621 in order to expedite prosecution of the present application. Accordingly, Applicants respectfully request withdrawal of this rejection.

Obviousness-Type Double Patenting Rejection of Previously Presented Claims 17-39 In View Of Claims 1-14 of U.S. Patent No. 6,641,921

Previously presented claims 17-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,641,921. This rejection is respectfully traversed.

Applicants respectfully submit that pending claims 17-24, 27-28 and 30-39 are patentably distinct from claims 1-14 of U.S. Patent No. 6,641,921 (claims 25-26 and 29 were previously cancelled). However, Applicants submit herewith a terminal disclaimer disclaiming any portion of the patent term of the present application that would extend beyond the patent term of U.S. Patent No. 6,641,921 in order to expedite prosecution of the present application.

Accordingly, Applicants respectfully request withdrawal of this rejection.

III. Conclusion:

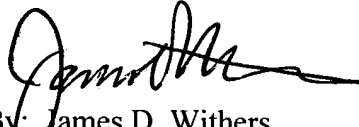
For at least the reasons given above, Applicants submit that claims 17-24, 27-28 and 30-39 define patentable subject matter. Accordingly, Applicants respectfully request allowance of these claims.

No additional fees are believed due; however, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 503025.

Should the Examiner believe that anything further is necessary to place the application in better condition for allowance, the Examiner is respectfully requested to contact Applicants' representative at the telephone number listed below.

Respectfully submitted,

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